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DETAILED ACTION

Prosecution History Summary

Claims 79-81 have been added.

Claims 40-41, 43-44, 47-53, 55-57, 60-65, 67, 71, 73, 76-81 are pending and rejected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/21/2011 has been entered.

Interview Summary and Proposed Amendments

The Examiner notes that, over the course of late March through the end of April, multiple attempts were made to discuss proposed amendments with Applicant. The Examiner proposed the below amendments to independent claims which put the claims in condition for allowance. As of the writing of this action, the Examiner has not received an indication from Applicant that either of the proposed amendments are approved for entry as an Examiner's Amendment. The amendments were proposed as follows:

Option 1: 40. (Currently amended) A method comprising:

informing a consumer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system, the informing comprising placing ~~an~~ a selectable indication within a catalog of the music sharing system indicating that the music selection is available for transmission to the intermediate storage medium, wherein selection of the selectable indication by the consumer causes an order for the music selection to be communicated without requiring other interaction by the consumer;

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receiving a consumer request for the music selection;
responsive to receiving the consumer request, transmitting the music selection to the intermediate storage medium at a consumer site;
receiving an indication that at least a portion of the music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site; and
responsive to receiving the indication, automatically charging, by a device, the consumer for the music selection.

Option 2: 40. (Currently amended) A method comprising:

informing a consumer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a peer to peer music sharing system, the informing comprising ~~placing an indication~~ highlighting the music selection within a catalog of the peer to peer music sharing system, thereby indicating that the music selection is available for transmission to the intermediate storage medium;

receiving a consumer request for the highlighted music selection;
responsive to receiving the consumer request, transmitting the highlighted music selection to the intermediate storage medium at a consumer site;

receiving an indication that at least a portion of the highlighted music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site; and

responsive to receiving the indication, automatically charging, by a device, the consumer for the music selection.

Option 1: 52. (Currently amended) A computer readable storage medium having computer executable instructions stored thereon, the instructions comprising:

instructions to inform a consumer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system, the instructions to inform comprising instructions to place ~~an~~ a selectable indication within a catalog of the music sharing system indicating that the music selection is available for transmission to the intermediate storage medium,

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wherein selection of the selectable indication by the consumer causes an order for the music selection to be communicated without requiring other interaction by the consumer;

instructions to receive a consumer request for a the music selection;

instructions to transmit, responsive to receiving the consumer request, the music selection to the intermediate storage medium;

instructions to receive an indication that at least a portion of the music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site; and

instructions to automatically charge, responsive to said indication, the consumer for the music selection.

Option 2: 52. (Currently amended) A computer readable storage medium having computer executable instructions stored thereon, the instructions comprising:

instructions to inform a consumer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a peer to peer music sharing system, the instructions to inform comprising instructions to ~~place an indication~~ highlight the music selection within a catalog of the peer to peer music sharing system, thereby indicating that the music selection is available for transmission to the intermediate storage medium;

instructions to receive a consumer request for the highlighted music selection;

instructions to transmit, responsive to receiving the consumer request, the highlighted music selection to the intermediate storage medium;

instructions to receive an indication that at least a portion of the highlighted music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site; and

instructions to automatically charge, responsive to said indication, the consumer for the music selection.

Option 1: 64. (Currently amended) An apparatus comprising:

a music sharing system including a catalog, the catalog configured to depict a selectable indication ~~means for informing a consumer~~ that a music selection is available for transmission to an intermediate storage medium at a consumer site via ~~a~~ the music sharing system, wherein the selectable indication is configured to cause an order for the music selection to be communicated without requiring

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other interaction by the consumer ~~the means for informing comprising means for placing an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium;~~

means for receiving a consumer request for the music selection;

means for transmitting the music selection, responsive to receiving the consumer request, to the intermediate storage medium at a consumer site; and

a central controller system configured to:

receive an indication that at least a portion of the music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site; and

charge the consumer for the music selection in response to receiving the indication.

Option 2: 64. (Currently amended) An apparatus comprising:

a peer to peer music sharing system including a catalog, the catalog configured to depict a highlighted music selection ~~means for informing a consumer indicating that a music selection is available for transmission to an intermediate storage medium at a consumer site via a the peer to peer music sharing system[[,]] the means for informing comprising means for placing an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium;~~

means for receiving a consumer request for the music selection;

means for transmitting the music selection, responsive to receiving the consumer request, to the intermediate storage medium at a consumer site; and

a central controller system configured to:

receive an indication that at least a portion of the music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site; and

charge the consumer for the music selection in response to receiving the indication.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Upon further review of Wiser and Hamada, the Examiner notes that the amended features are taught by Wiser. More specifically, Wiser provides an indication as part of a preview process which enables the user to decide whether to purchase the entirety of the song for permanent storage on a hard disk (intermediate storage) of client system and subsequent recording to a CD-R or other portable medium [see at least: col. 13 lines 52-63, Fig. 8]. As part of the preview page, the user is indicated that songs are available for purchase (i.e. permanent storage in hard disk), with the indication including a button (analogous to an icon) which causes the purchase to be effected [see at least: col. 19 lines 15-21, Fig. 9AA #902]. In this regard, Wiser effectively teaches informing a customer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system, the informing comprising placing an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium as well as where the indication includes either a highlight or an icon.

With respect to the rejection of claims 40-41, 43-53, 55-65, 67, 71, 73-78 under 35 USC 112 (first and second paragraphs), Applicant's amendments have overcome the noted rejections. Those grounds are hereby withdrawn; However, in view of the amendments to claim 64, certain deficiencies under 35 USC 112 have been noted below regarding claim 64 and its dependents.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 64-65, 67, 71, 73, 78, and 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 64, Claim 64 recites the elements “means for informing” and “means for placing and indication” that represent means (or step) plus function limitations invoking 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. More specifically, Applicant does not clearly describe what structure or acts are material to the “informing” or placement of the indication. Moreover, assuming said limitations are drawn to program code/software, then the Examiner hereby asserts that Applicant has failed to set forth any algorithm, coding, or the like necessary to perform the necessary functionality.

With respect to claim 65 and 73, similar to independent claim 64, these claims recite means for elements that are not adequately described in Applicant’s specification so as to clearly link or associate what is considered the “means for”. As with claim 64, and assuming said limitations are drawn to program code/software, the Examiner again asserts that Applicant has failed to set forth any algorithm, coding, or the like necessary to perform the necessary functionality.

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With respect to claims 67, 71, 78, and 81, these claims are rejected merely because they depend from claim 64 and inherit the deficiencies of claim 64. The recited “means for” in these claims are clear from Applicant’s specification and meet the requirements of 35 USC 112, 6th paragraph.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-41, 48-51, 52-53, 60-63, 64-65, 67, 71, and 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser (US 7263497) in view of Hamada (US 6792007).

Regarding claim 40, Wiser teaches a method comprising:

informing a customer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system, the informing comprising placing an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium [see at least: col. 13 lines 52-63, col. 19 lines 15-21, Fig. 8, Fig. 9AA #902];

receiving a consumer request for a music selection [see at least: col. 12 lines 12-19, col. 17 lines 21-33, Fig. 7 #702-704, Fig. 8, Fig. 14];

responsive to said consumer request, transmitting the music selection to an intermediate storage medium at a consumer site [see at least: col. 12 lines 12-19, col. 13 lines 57-63, col. 18 lines 6-19 and 39-51, col. 18 line 63-col. 19 line 10, Fig. 7 #710-730];

receiving an indication that at least a portion of the music selection has been recorded in said intermediate storage medium and that a subsequent request to purchase the media selection, said purchase request including a request to store the music selection in a permanent storage medium at said consumer site [see at least: col. 12 lines 12-19, col. 19 lines 18-22, col. 20 lines 45-49 and 56-57, col. 21 lines 41-46, col. 22 lines 56-58, col. 29 lines 4-12, col. 31 lines 24-37];

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responsive to said indication, automatically charging the consumer for the music selection [see at least: col. 19 lines 28-43, col. 20 lines 56-57, col. 21 lines 1-4 and 26-35].

Though teaching all of the above including receiving an indication a subsequent request to purchase the media selection, said purchase request including a request to store the music selection in a permanent storage medium at said consumer site, Wiser only teaches where charging is done prior to the storage of the media in permanent storage media. In other words, Wiser does not expressly teach where the charging is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site (i.e. charging takes place after the media is permanently stored).

In the same field of endeavor, Hamada teaches a system and method for distribution of media content. More importantly, Hamada teaches where the charging is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site [see at least: col. 6 lines 36-52, col. 7 lines 55-67, Fig. 14 #s206-208].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser to have included the noted features as taught by Hamada because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the invention of Hamada would improve the invention of Wiser by providing a system and method which are more capable of ensuring the protection of data with respect to illicit transfer of specific data [see at least: Hamada, col. 2 lines 17-24].

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Regarding claim 41, the combination further teaches where the automatically charging is done electronically [see at least: Wiser, col. 19 lines 28-43, col. 20 lines 56-57, col. 21 lines 1-4 and 26-35].

Regarding claim 48, the combination further teaches transmitting to the consumer site, for storage on a storage medium at the consumer site, information identifying music selections available for transmission to the intermediate storage medium [see at least: Wiser, Fig. 8, Fig. 14].

The combination would have been obvious for at least the reasons above.

Regarding claim 49, the combination further teaches before automatically charging the consumer for the music selection, receiving an indication that the entire music selection has been recorded on the permanent storage medium [see at least: Hamada, col. 6 lines 36-52, col. 7 lines 55-67].

The combination would have been obvious for at least the reasons above.

Regarding claim 50, Wiser further teaches communicating an order of said music selection to a central controller, transferring copies of records of said order to a transmission scheduler, [see at least: col. 13 lines 64-67, col. 18 lines 26-51, Fig. 1 #112 and 118, Fig. 7 #710-730 (Note: content manager/delivery server are analogous to a central controller and transmission scheduler) and

communicating schedules created by said transmission scheduler to an uplink facility for transmission of said order [see at least: col. 17 lines 29-41, col. 19 lines 18-22, col. 20 lines 56-57, col. 21 lines 41-46, col. 29 lines 4-12, col. 31 lines 24-37]. .

Hamada teaches the missing steps of a satellite uplink and transmitting via satellite said order to said customer site [see at least: col. 4 lines 50-62, Fig. 1, Fig. 14].

The combination would have been obvious for at least the reasons above.

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Regarding claim 79, the combination further teaches wherein the indication comprises either a highlight or icon [see at least: Fig. 8, col. 13 lines 52-63, col. 19 lines 15-21].

Regarding claim 51, the combination teaches an action selected from the group consisting of: using a home personal computer for ordering said music selection, using a cell phone for ordering said music selection, using a PDA wireless device for ordering said music selection; ordering said music selection via wireless application protocol [see at least: Wiser, col. 12 lines 12-19, col. 13 lines 57-63, col. 18 lines 6-19 and 39-51, col. 18 line 63-col. 19 line 10, Fig. 7 #710-730].

Regarding claims 52-53 and 60-63, 64-65, 67, 71, and 80-81, these claims closely parallel claims 40-41, 48-51, and 79 and are thereby rejected for at least similar rationale.

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Claims 43, 55, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada as applied above, in further view of PTO form 892 reference U (892u).

Regarding claim 43 and related claims 55 and 73, Wiser in view of Hamada teaches :

informing the consumer that the music selection is available for transmission to an intermediate storage medium of a music sharing system and

providing a mechanism for the consumer to request the music selection while at a website of the music sharing system [see at least: Wiser, col. 12 lines 12-19, col. 17 lines 22-27, Fig. 1 #126, , Fig. 8].

Wiser in view of Hamada, however, does not expressly teach where the music sharing system is a peer to peer system .

In the same field of endeavor, 892u teaches the advent of Napster.com – a website/software supporting a virtual community and search engine that makes it a good way to find MP3 files and associated resources. In this regard, 892u teaches where the music sharing system is a peer to peer sharing system.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser in view of Hamada to have included the noted features as taught by 892u because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, 892u would improve the invention of Wiser and Hamada by providing a virtual community for sharing media that combines almost all needed functions such as searching and downloading desired media into a single application [see at least: 892u].

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Claims 44 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada in view of PTO form 892 reference U (892u) as applied to claims 43 and 55, and further in view of Wolff (6247047).

Regarding claim 44 and related claim 56, the combination of Wiser, Hamada, and 892u teaches all of the above including making music available for transmission to the intermediate storage medium (Wiser) and further where the music sharing system includes a peer to peer system (892u). The combination, however, does not expressly teach paying an operator of said peer to peer music sharing system for advertising.

In the field of electronic commerce, Wolff teaches the payment of a fee to a sponsor server (operator) by a merchant for advertising [see at least: col. 7 lines 21-25].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser in view of Hamada in view of 892u to have included the noted features as taught by Wolff because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the invention of Wolff would improve the system and method of Wiser, Hamada, and 892u by providing a banner advertising transaction enabling system on a computer network such as the Internet for use even by merchants with little or no presence on the computer network, therein crating a system that is inexpensive compared with conventional banner advertising systems [see at least: Wolff, col. 3 lines 31-36].

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Claims 47 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada in view of PTO form 892 reference U (892u) as applied to claims 43 and 55, and further in view of Allen (US 20030036974).

Regarding claim 47 and related claim 59, the combination of Wiser, Hamada, and 892u teaches all of the above including making music available for transmission to the intermediate storage medium (Wiser) and further where the music sharing system includes a peer to peer system (892u). The combination, however, does not expressly teach creating a profile from customer preference information.

In the same field of endeavor, Allen teaches a content distribution system including creating a profile from customer preference information [see at least: 0013, 0078-0080].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser in view of Hamada in view of 892u to have included the noted features as taught by Allen because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the invention of Allen would improve the system and method of Wiser, Hamada, and 892u by promoting to a specific consumer those items which such consumer's previous system activities indicate he or she may be predisposed to purchase (or show additional interest in) [see at least: Allen, 0013].

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Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada in view of Doyle (US 5694551).

Regarding claim 76 and related claims 77-78, Wiser teaches all of the above including transmitting pricing information for the music selection to a customer station located at the customer site [see at least: col. 11 lines 49-50]. Wiser further teaches where information pertaining to the music selections may be updated [see at least: col. 18 lines 32-36]. Wiser, however, does not expressly teach

periodically transmitting updated pricing information for the music selection to the customer station;

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information.

In the same field of endeavor, Doyle teaches periodically transmitting updated pricing information for the music selection to the customer station;

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information [see at least: col. 4 lines 28-35, col. 5 lines 61-65 (product item update), col. 7 lines 19-24, col. 8 lines 61-67, col. 9 lines 13-21]. Note: the price paid by the customer is the updated price, thus, the customer is charged in accordance with the updated price.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser and Hamada to have included the noted features as taught by Doyle because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on Monday-Friday, 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Will Allen
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